



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/069,703	04/29/1998	GILLES H. TAPOLSKY	VIRO:034	3665

25226 7590 11/26/2002
MORRISON & FOERSTER LLP
755 PAGE MILL RD
PALO ALTO, CA 94304-1018

EXAMINER

WEBMAN, EDWARD J

ART UNIT	PAPER NUMBER
----------	--------------

1617

DATE MAILED: 11/26/2002

31

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/069703

Applicant(s)

TOPOLSKY

Examiner

WEBMAN

Group Art Unit

1617

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7/29/02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-10, 12, 13, 15-18, 33, 34 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-9, 12, 15, 17-18, 34 is/are rejected.
- ☒ Claim(s) 10, 13, 16, 33 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 9, 12, 15, 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Takayanagi et al.

Takayanagi et al teach a medical tape for oral mucosa comprising a support layer and a medical layer composed of a water-soluble polymer (abstract). PVP, sodium polyacrylate, and carboxyl cellulose are specified (column methyl 2 lines 61-64). A second polymer, hydroxypropyl cellulose, is specified (column 3 lines 61-64). The medicament layer may be composed of two or more layer^f (column 3 lines 18-19). One or more water-soluble polymers are disclosed (column 2 line 68 column 3 line 2). Methylcellulose is specified (column 2 lines 65-66). Diss^{im} solution^{im} the may be varied by proper selection of polymers (column 3, lines 29-33) ant^{im} inflammatory steroids are disclosed (column 2 lines 48-53). A 200 um thickness is specified (column 3, lines 15-16).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1617

Claims 1-9, 12, 19, 17-18, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayanagi et al in view of WO 95/05416 (^{WO}'416) and EPA 250187 (EPA '187).₁

Takayanagi et al is discussed above.

WO '416 teaches overlaying and adhesive layer to prevent leakage of active from edges (page 30 lines 16-24).

EPA '187 teaches an intra-oral film (Title). Flavors are disclosed as customary (page 4, lines 41-43).

It would have been obvious to one of ordinary skill to overlay and adhesive layer in Takayanagi et al to achieve the beneficial effect of preventing Leakage of active from edges in view of WO '416 and to add a flavor as a customary additive in intr-oral films in view of EPA '187.^a

Claims 1-9, 12, 15, 17-18, 34 are rejected.

Claims 10, 13, 16, 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Webman whose telephone number is (703) 308-4432. The examiner can normally be reached on Monday to Friday 9 Am 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Padmanabhan can be reached on (703) 308-0570. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

Application/Control Number: 09/069,703

Page 4

Art Unit: 1617

305-3592 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Webman/LR
November 5, 2002


EDWARD C. WEBMAN
PRIMARY EXAMINER
GROUP 1500